

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed July 27, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims 1-6, 11-14 and 19-25**

Claims 1-6, 11-14, and 19-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mandalia, et al. ("Mandalia," Pat. No. 5,907,598) in view of Chang, et al. ("Chang," U.S. Pub. No. 2003/0095542A1) and further in view of Matsubayashi (EP 1109113A2). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action. Applicant discusses the various applied references and their applicability to Applicant's claims in the following.

As an initial matter, Applicant notes that the Matsubayashi reference is a foreign patent application that was published *after* Applicant's filing date. Because of this fact, the Matsubayashi reference does not qualify as prior art as to Applicant's claims under

any section of 35 U.S.C. §102, which determines what references can be applied under 35 U.S.C. §103. In view of this fact, Applicant respectfully submits that the rejection is improper and should be withdrawn.

Turning to the Mandalia reference, Mandalia discloses multimedia web page applications. More particularly, Mandalia teaches repositories that receive facsimile transmissions, converts them to Hypertext Markup Language (HTML) web page format, stores the converted transmissions, and renders the transmissions for simultaneous *viewing* by multiple users of the Internet. Mandalia, Abstract, lines 1-12; column 2, lines 30-50.

In contrast to facilitating mere viewing of fax data, Applicant's claims pertain to facilitating *printing* of fax data. For example, original claim 1 provides (emphasis added):

1. A method providing a facsimile service, the method comprising:
  - receiving a facsimile sent to a telephone number;
  - responsive to receiving the facsimile:
    - (a) *converting the facsimile from a fax format to a printable data format;*
    - (b) *wrapping the converted facsimile in a network transfer protocol language;*
    - (c) identifying a Universal Resource Locator (URL) that corresponds to the telephone number, *the URL identifying an embedded web server in a printer;* and
    - (d) *communicating the wrapped facsimile to the embedded web server for printing by the printer.*

In the Office Action, it is stated that Mandalia discloses “converting the facsimile from a fax format to a printable data format”. This is simply not true. As is noted above, Mandalia only teaches converting a facsimile from a fax format to a “web page format” so that the fax data can be viewed over the Internet (e.g., using a conventional browser). Mandalia says nothing about conversion to a “printable data format” or actually printing the data. As is well-known in the art, printable data formats, also known as print ready formats, are those formats that a printer can accept and print without further conversion, such as the conversion by a printer driver on a personal computer. Applicant’s claimed invention converts the facsimile to a printable data format because the data is being directly provided to a printer. Without such conversion, the facsimile could not be printed unless the printer had an appropriate driver that could first convert the facsimile into a printable data format.

That Mandalia does not teach converting a facsimile from a fax format to a printable data format is clear given the fact that Mandalia only anticipates displaying the fax data over the Internet. If Mandalia converted the facsimile from a fax format to a printable data format as claimed by Applicant, Mandalia would not even be able to display the fax data, thereby negating the primary purpose of Mandalia’s invention.

Given that Mandalia does not disclose converting a facsimile from a fax format to a printable data format, it logically follows that Mandalia does not disclose “wrapping the converted facsimile in a network transfer protocol language”, as is also required by independent claim 1. First, the recited “converted facsimile” is the fax data in the printable data format. Second, although Mandalia discloses conversion to a web page format, Mandalia is silent as to “wrapping” a facsimile in a network transfer protocol language.

Although the Office Action states that Mandalia discloses the “converting” and “wrapping” limitations, the Office Action further cites the Chang reference, for the proposition that it would have been obvious to convert a facsimile into a printable data format. As is provided in the Office Action:

*An artisan working with Mandalia invention at the time of the invention would have been motivated to look for teaching that may have allowed a printer to function as device for receiving a facsimile (fax). In these arts, Change disclosed a pseudo fax/phone number defined to uniquely identify a printer and “once a printer is assigned pseudo fax number, the printer can receive faces sent to that pseudo number just like a face machine. The fax gateway in the called gateway server converts the received fax into a printable form before sending the received fax to print . . .” . . .*

*Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teaching of Change related to converting a facsimile/fax format to a printable format . . .*

Applicant respectfully submits that the above argument ignores the core teachings of the Mandalia reference. As is noted above, Mandalia is only concerned with *displaying* fax data over the Internet so that multiple persons can *view* the data at the same time, for instance during voice conferences. Mandalia describes the difficulties of conventional faxing (i.e., transmitting to a device that generates a hard copy facsimile) in this context. Specifically, Mandalia states (emphasis added):

For example, a user preparing for a voice conference with other users, and having a number of charts to present, *can not simply broadcast facsimile copies of the charts to all prospective conference attendees, and transmitting such copies sequentially to prospective*

*attendees requires that an operating fax machine or the equivalent be closely accessible to each prospective attendee, and also pre-supposes that all of the fax machines so deployed with operate satisfactorily (not fail) during the transmissions.*

Accordingly, Mandalia indicates that conventional faxing has several attendant disadvantages. Mandalia's solution is to avoid such conventional faxing altogether. In other words, Mandalia's solution is to broadcast the fax data as a web page instead of transmitting a facsimile to a device such as an "operating fax machine of the equivalent" for printing. Therefore, Mandalia actually *teaches away* from a solution, such as that taught by Chang, in which fax data is printed out by a printer or other printing device. Mandalia further states that his solution provides several advantages over conventional faxing (i.e., printing) including the fact that "distributed data can be made available to a large population of potential viewers (e.g. any of today's web users, subject to appropriate authorization) at a lower cost than would be possible if the distributed data were routed by standard handling in point-to-point fax transmissions from sender to individual receivers . . ."

In view of the above, it is clear that, contrary to that alleged in the Office Action, it would not have been obvious to combine the teachings of Chang with those of Mandalia to modify the Mandalia system. In contradistinction, such a person would be motivated *against* such modification given that Mandalia specifically teaches away from such a modification. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant .

. .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

In view of the above, it follows that it likewise would not have been obvious to identify a URL that corresponds to a telephone number, “the URL identifying an embedded web server in a printer” or “communicating the wrapped facsimile to the embedded web server for printing by the printer”, as are further required by independent claim 1. Applicant also notes that, even if the Matsubayashi reference were properly citable against Applicant’s claims, the Matsubayashi reference would not be properly combinable with the Mandalia reference due to Mandalia’s teaching away from printing of fax data. Accordingly, Matsubayashi would not provide the missing teachings for an “embedded web server” of a “printer” as is recited in independent claim 1.

Regarding independent claim 12, the proffered combination does not render obvious any of “converting the facsimile from a fax format to a printable data format”, “wrapping the converted facsimile in a network transfer protocol language”, “identifying a Universal Resource Locator (URL) that corresponds to the telephone number; the URL identifying a web server module that is embedded in a printer”, “communicating the wrapped facsimile to the web server for printing by the printer”, “receiving, by the web server module, the communicated facsimile”, or “responsive to receiving the communicated facsimile, printing, by the printer, the communicated facsimile”. As is described in detail above in relation to claim 1, Mandalia teaches away from solutions in which fax data is transmitted to a machine that outputs the data as a hard copy.

Regarding independent claim 20, the proffered combination does not render obvious an apparatus comprising any of “an embedded web server module that is

operatively coupled to the service provider module”, “a printer module operatively coupled to the embedded web server module”, or a service provider module that is “configured to receive a facsimile sent to a telephone number that corresponds to the embedded web server module, and communicate the facsimile to the embedded web server module in a manner that enables the printer module to print the communicated facsimile”. As is described in detail above in relation to claim 1, Mandalia teaches away from solutions in which fax data is transmitted to a machine that outputs the data as a hard copy.

In summary, it is Applicant’s position that a proper case for obviousness has not been made against Applicant’s independent claims 1, 12, and 20, or the claims which depend therefrom. Therefore, it is respectfully submitted that the rejection of these claims should be withdrawn.

**B. Rejection of Claims 7-10, 15-18 and 26-30**

Claims 7-10, 15-18, and 26-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mandalia in view of Chang and Matsubayashi, and further in view of “what would have been obvious to one of ordinary skill in the art at the time the invention was made.” Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1, 12, and 20, the applied references do not teach or render obvious several of Applicant’s explicit claim limitations. In that no other reference is cited to account for those limitations, Applicant submits that claims 7-10, 15-18, and 26-30 are allowable for at least the same reasons that claims 1, 12, and 20 are allowable.

**C. Rejection of Claims 31-32**

Claims 31-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsubayashi in view of Mandalia. Applicant respectfully traverses this rejection.

As is discussed above in relation to claims 1, 12, and 20, the Matsubayashi reference does not qualify as prior art as to Applicant's claims and, therefore, is not properly citable against Applicant's claims. Applicant submits that the rejection is therefore improper and should be withdrawn.

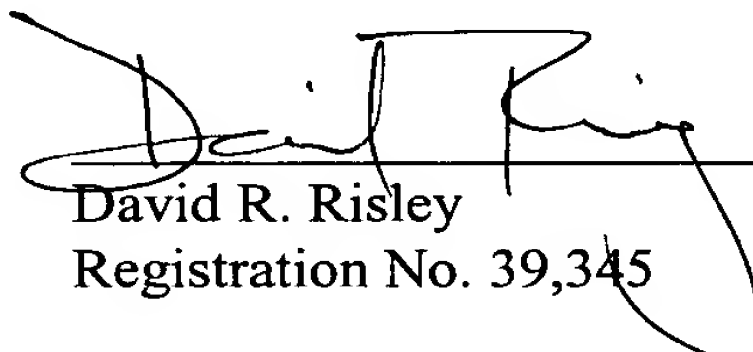
As a further point, Applicant incorporates the discussion of the Mandalia reference provided in the foregoing and asserts that Mandalia teaches away from the "printer" described in claim 31. Specifically, Mandalia teaches away from using a printer or other such device to print out facsimiles.



### CONCLUSION

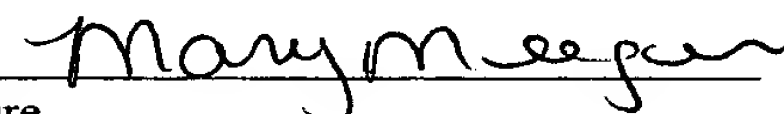
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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